

## **REMARKS**

### **I. Introduction**

Claims 34 to 52 are pending in the present application. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that the claims are now in condition for allowance. Applicants point out that the amendments made herein are made without prejudice to the future prosecution of such cancelled, amended, or modified subject matter in a related divisional, continuation, or continuation-in-part application.

### **II. Rejection of Claims 34 to 39 and 41 to 50 Under 35 U.S.C. § 102(b)**

Claims 34 to 39 and 41 to 50 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,718,682 ("Tucker"). It is respectfully submitted that Tucker does not anticipate these claims for at least the following reasons.

Claim 34 recites that a port for a catheter includes a chamber for receiving active substances, the chamber being arranged in a housing and closed off by a piercable membrane, and a connecting piece, the connecting piece being capable of connecting to the catheter and in fluid connection with the chamber. Claim 34 also recites that the port includes clamping jaws, the clamping jaws having clamping faces that are situated opposite one another, the clamping jaws being **movable from a first position, in which the clamping jaws are spaced away from the housing laterally, to a second position in which the clamping jaws fix the catheter in place between their clamping faces by a clamping action.**

Although Applicants do not agree with the merits of the present rejection, to facilitate prosecution, claim 34 has been amended herein without prejudice to recite that the clamping jaws are **connected to the housing when the clamping jaws are in each of the first position and the second position.** Support for this amendment may be found, for example, at page 7, line 30 to page 8, line 2 of the Substitute Specification.

Tucker discloses, referring to Figure 4, an implantable access port device comprising a housing 42, a septum 44, and a cup unit 46. The septum 44 and the cup unit 46 are inserted into the housing 42. The cup unit 46 comprises a cup-shaped element 54 and cup ring halves 56a and 56b. These components are mechanically compressed together while the bottom of the cup element is subjected

to vibration at ultrasonic frequencies, thereby melting and permanently welding the components together. See col. 4, lines 29 to 40.

The Examiner contends that the ring halves 56a and 56b constitute clamping jaws. As best understood by Applicants, the Examiner further contends that the position of the ring halves 56a and 56b as shown in broken lines in Figure 6 constitutes a first position as recited in claim 34. However, it is abundantly clear that, in the position shown in broken lines in Figure 6, the ring halves 56a and 56b are completely separate from any other elements. In this regard, Tucker does not disclose, or even suggest, clamping jaws movable from a first position, in which the clamping jaws are spaced away from a housing laterally, to a second position, in which the clamping jaws fix a catheter in place between their clamping faces by a clamping action, the clamping jaws being connected to the housing when the clamping jaws are in each of the first position and the second position.

It is "well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office." Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

As indicated above, Tucker does not disclose, or even suggest, all of the features recited in claim 34. As such, it is respectfully submitted that Tucker does not anticipate claim 34 or any of claims 35 to 39 and 41 to 50, which ultimately depend from claim 34.

In view of all of the foregoing, withdrawal of the present rejection is respectfully requested.

### **III. Rejection of Claim 40 Under 35 U.S.C. § 103(a)**

Claim 40 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Tucker and U.S. Patent No. 6,165,157 ("Dillon et al."). It is respectfully submitted that the combination of Tucker and Dillon et al. does not render claim 40 unpatentable for at least the following reasons.

Claim 40 depends from claim 34 and therefore includes all of the features recited in claim 34. As more fully set forth above, Tucker does not disclose or suggest all of the features of claim 34. Dillon et al. is not relied upon for disclosing the features of claim 34 not disclosed or suggested by Tucker. Indeed, Dillon et al. does not disclose, or even suggest, the features of claim 34 not disclosed or suggested by Tucker.

In view of the foregoing, it is respectfully submitted that the combination of Tucker and Dillon et al. does not disclose, or even suggest, all of the features of claim 40. As such, it is respectfully submitted that the combination of Tucker and Dillon et al. does not render unpatentable claim 40. Accordingly, withdrawal of this rejection is respectfully requested.

### **IV. Rejection of Claims 51 and 52 Under 35 U.S.C. § 103(a)**

Claims 51 and 52 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Tucker and U.S. Patent No. 5,167,638 ("Felix et al."). It is respectfully submitted that the combination of Tucker and Felix et al. does not render unpatentable these claims for at least the following reasons.

Claims 51 and 52 ultimately depend from claim 34 and therefore include all of the features recited in claim 34. As more fully set forth above, Tucker does not disclose or suggest all of the features of claim 34. Felix et al. is not relied upon for disclosing the features of Tucker not disclosed or suggested by Tucker. Indeed, Felix et al. does not disclose, or even suggest, the features of claim 34 not disclosed or suggested by Tucker.

In view of the foregoing, it is respectfully submitted that the combination of Tucker and Felix et al. does not disclose or suggest all of the features of either of claims 51 and 52. As such, it is respectfully submitted that the combination of Tucker and Felix et al. does not render unpatentable either of claims 51 and 52. Accordingly, withdrawal of these rejections is respectfully requested.

**V. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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By: /Daniel S. Matthews/  
Daniel S. Matthews  
Reg. No. 63,277

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO. 26646**